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EXAMINER
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NAFF, DAVID M

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* LOTTE RUGHOLM HENRIKSEN and ERIK MARCUSSEN

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Appeal 2008-1881  
Application 10/618,477  
Technology Center 1600

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Decided: January 22, 2009

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Before TONI R. SCHEINER, DEMETRA J. MILLS, and RICHARD M.  
LEBOVITZ, *Administrative Patent Judges*.

LEBOVITZ, *Administrative Patent Judge*.

DECISION ON REQUEST TO REOPEN PROSECUTION

Appellants have requested that prosecution be reopened pursuant to 37 C.F.R. § 41.50(b)(1) to respond to the new ground of rejection (“Request”) set forth in the Board decision entered July 8, 2008 (“Decision”).

ISSUE

Whether Appellants made a proper request under 37 C.F.R. § 41.50(b)(1) to reopen prosecution?

### REPRESENTATIVE CLAIM

Claim 34 is representative of the appealed subject matter:

34. A solid phytase composition, comprising:  
    (a) an enzyme having a phytase activity of above 20 FYT<sup>[1]</sup>/g of the composition, and  
    (b) corn steep liquor in an amount sufficient to stabilize the enzyme having phytase activity.

### DISCUSSION

In the Decision entered July 8, 2008, we affirmed the Examiner's rejection of claims 34-38 and 40-52. Because our rationale differed from the Examiner's, we designated it as a new ground of rejection under 37 C.F.R. § 41.50(b) to provide Appellants with an opportunity to respond to it (Dec. 9-10).

The background of the case is as follows:

Claims 34-38 and 40-52 stand rejected under 35 U.S.C. § 103(a) as obvious over prior art (Ans. 4). The claims are directed to a phytase composition comprising phytase enzyme and corn steep liquor "in an amount sufficient to stabilize the enzyme having phytase activity."

In their Appeal Brief, Appellants did not challenge the adequacy of the Examiner's prima facie case. Rather, Appellants' took the position that Examples 4-7 of the Specification provided evidence of "surprising and unexpected" results sufficient to rebut the Examiner's conclusion of obviousness (App. Br. 13). These results purport to show that the corn steep liquor "significantly" improves the stability of phytase in a composition as

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<sup>1</sup> "FYT" refers to a unit of enzyme activity, "one FYT being the amount of enzyme that liberates 1 micro mole inorganic ortho-phosphate per min" under specific conditions (Spec. 2: 32-36).

compared to a control which lacks the liquor (App. Br. 12-13). The Examiner rejected this evidence, asserting that the prior art suggests combining phytase with corn steep liquor and that the liquor's effect in stabilizing phytase would have been an inherent property of the obvious combination (Ans. 8-9).

In our Decision, we concluded that the Examiner erred in not considering Appellants' evidence of unexpected results (Dec. 7). Unexpected results are invoked to rebut prima facie obviousness. The properties relied upon as a basis for the unexpected results are inseparable from, and therefore "inherent" to whatever materials and methods are utilized to generate the results. However, this does not demean their ability to serve as a basis for patentability. Rather, the question is whether the evidence of unexpected results is based on a comparison with the closest prior art and whether the property relied upon as the basis for the results would also have been possessed by the closest prior art (Dec. 9). Applying these correct principles, we reviewed the evidence of unexpected results and found them inadequate on the record before us to rebut the prima facie case.

An appellant may respond to new ground of rejection by (1) reopening prosecution or (2) requesting rehearing of the Decision on the same record. *See* 37 C.F.R. § 41.50(b). According to § 41.50(b)(1), Appellant must:

Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new evidence not previously of record is made

which, in the opinion of the examiner, overcomes the new ground of rejection stated in the decision.

In this case, Appellants have not submitted a claim amendment, nor have they provided new evidence as necessary under § 41.50(b)(1) to have a proceeding remanded to the Examiner. As neither requirement has not been met, we deny Appellants' request to reopen prosecution.

In their Request, Appellants argue as they did in the Appeal Brief. They do not identify any defect in our Decision. Rather, they re-argue the same position taken in the Appeal Brief.

They state in the Request, without explanation, that the “formulations containing phytase without corn steep liquor [used in the Examples as the basis for the comparison] represent the closest prior art” (Request 2). However, Appellants have not stated that the formulations are those represented by DeLima, which the Examiner relied upon as the closest prior art, or whether Appellants are referring to other uncited prior art. The Examiner made specific findings about the enzyme-containing granules described in DeLima (*see* Ans. 4-5; FF1-4<sup>2</sup>), but Appellants have not explained whether the granules utilized in their Examples have these characteristics. Finally, Appellants have not explained how the results are commensurate in scope with the full scope of the claims, a necessary condition to rebut prima facie obviousness of the claimed subject matter. *See In re Harris*, 409 F.3d 1339, 1344 (Fed. Cir. 2005).

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<sup>2</sup> “FF” refers to the Findings of Fact set forth in the Decision.

CONCLUSION OF LAW

Appellants did not make a proper request under 37 C.F.R. § 41.50(b)(1) to reopen prosecution because they did not submit a claim amendment or new evidence as necessary under the rule to have a proceeding remanded to the Examiner. The Request to Reopen Prosecution is therefore denied.

DENIED

Ssc:

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